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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,419	02/09/2004	Ta-Hai Hung	MR3287-8	6584
4586	7590	06/13/2005	EXAMINER	
ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043			CRANE, DANIEL C	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/773,419	<b>Applicant(s)</b> HUNG ET AL.	
	<b>Examiner</b> Daniel C Crane	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some    \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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## **BASIS FOR REJECTIONS**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

## **SPECIFICATION OBJECTION**

The specification is object to because of the use of non-idiomatic English. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with non-idiomatic terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: "...for cutting an adequate length of the material 10 and a heating process for forming a head" (page 1, lines 9-11), "...the heading process generates lots of waters" (page 1, lines 25 and 26), "...the first and second dieses" (page 2 line 23), "...decrease the fail off rate" (page 3, line 5), "...display the design of the getting deeper." (page 5, line 18). These are such a few of the numerous non-idiomatic English phrases used to describe the various features of the invention.

Applicants are required to review and amend the specification in response to this Office Action to supply more clear language of the inventive features.

## **REJECTION OF CLAIMS ON FORMAL MATTERS**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The wording of the claims is difficult to follow and thus results in claims whose scope is indeterminate because of the indefinite language. For example, claim 1 uses phrases such as “closing the end of the path” and “deposited opposite”, which are contorted limitations that could be confusing. Applicant is required to place the claims in proper idiomatic English so as to eliminate any confusion of the claimed subject matter.

## **REJECTION OF CLAIMS OVER PRIOR ART**

Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Katsusuke (Japanese document no. 2003-164938). Katsusuke shows in Figure 2, 3 and 8 a first die 11 fastened to a machine (see Figure 1) and a second die driven along a linear path. Katsusuke further shows that the first die 11 is provided with an electrode plate or sensitive member 44 on the “top” surface of the first die 11. It is clearly evident that the sensitive member is embedded within the top surface of the first die 11 since the plate is flush with the first die surface. Accordingly, a “channel” is inherently provided to receive the electrode plate 44. Furthermore, to properly work, the

sensitive member would have to be insulated from the die. The “top” surface of the first die 11 is “lower” than the “top” surface of the second die, since the first die 11 is positioned below the movable second die 12 as seen in Figure 1. Accordingly, the features of claim 1 are met.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsusuke (Japanese document no. 2003-164938). The remarks set forth in the above paragraph are incorporated herein. Reversing the location of the sensitive member so that the sensitive member is within the second die rather than the first die would merely involve switching of the sensitive member from one die to the other die. An equivalent result would be foreseen. Accordingly, the skilled artisan having the benefit of Katsusuke’s invention would have been disposed to place the sensitive member in either the first die or the second die depending upon hardware availability and machine convenience. As to claims 3 and 4, the feature where one of the dies is provided with opposed thread rolling surfaces is known in the art to increase the use of the one die. Similarly, it would have been obvious to the skilled artisan in light of this known provision to also provide another inspective means on the reverse surface of the die from the surface having the one inspective means.

Claim 1 is further rejected under 35 U.S.C. 102(b) as being anticipated by Allebach (5,560,238). See Figures 1 and 2 where a second die 17 is opposed to a first die 16 and where an inspective means includes a sensitive member 66 positioned in a channel 46, 65, 58 at a location that is lower than the top of the second die 17. Clearly, insulative material is disposed between

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the sensitive member 66 and the first die so as to prevent short-circuiting of the sensitive member.

Claims 2-4 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Allebach (5,560,238). The remarks set forth in the immediately above paragraph are incorporated herein. Reversing the location of the sensitive member so that the sensitive member is within the second die rather than the first die would merely involve switching of the sensitive member from one die to the other die. An equivalent result would be foreseen. Accordingly, the skilled artisan having the benefit of Allebach's invention would have been disposed to place the sensitive member in either the first die or the second die depending upon hardware availability and machine convenience. As to claims 3 and 4, the feature where one of the dies is provided with opposed thread rolling surfaces is known in the art to increase the use of the one die. Similarly, it would have been obvious to the skilled artisan in light of this known provision to also provide another inspective means on the reverse surface of the die from the surface having the one inspective means.

#### **PRIOR ART CITED BY EXAMINER**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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## **RESPONSE BY APPLICANT(S)**


Applicant(s) response to be fully responsive and to provide for a clear record must specifically point out how the language of the claims patentably distinguishes them from the references, both those references applied in the objections and rejections and those references cited in view of the state of the art in accordance with 37 CFR 1.111 (a), (b) and (c).

## **INQUIRIES**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is **(571) 272-4516**. The examiner's office hours are 6:30AM-5:00PM, Tuesday through Friday. The examiner's supervisor, Mr. Derris Banks, can be reached at **(571) 272-4419**.

Documents related to the instant application may be submitted by facsimile transmission at all times to Fax number (703) 872-9306. Applicant(s) is(are) reminded to clearly mark any transmission as "DRAFT" if it is not to be considered as an official response. The Examiner's Fax number is **(571) 273-4516**.

DCCrane  
May 20, 2005



**Daniel C. Crane**  
Primary Patent Examiner  
Group Art Unit 3725